P24171.P08

DAW

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Attorney Docket No. P24171

In re application of: Yoshiyuki MURAOKA et al.

Mail Stop Amendment

Application No. : 10/654,881

Group Art Unit : 1745

Filed : September 5, 2003

Examiner : Laura Weiner

For : RECHARGEABLE BATTERY ABD MANUFACTURING METHOD THEREOF

Mail Stop Amendment
Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Transmitted herewith is an **Election with Traverse** in the above-captioned application.

____ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.

____ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.

____ An Information Disclosure Statement, PTO Form 1449, and references cited.

____ A Request for Extension of Time.

X No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 10	*20	0	x25=	$	x 50=	$0.00
Indep. Claims: 2	**3	0	x100=	$	x200=	$0.00
Multiple Dependent Claims Presented			+180=	$	+360=	$0.00
Extension Fees for __ Month(s)				$		$0.00
			Total:	$	Total:	$0.00

* If less than 20, write 20
** If less than 3, write 3

____ Please charge my Deposit Account No. 19-0089 in the amount of $_____.

N/A A check in the amount of $___ to cover the filing/extension fee is included.

X The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

X Any additional filing fees required under 37 C.F.R. 1.16.

X Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 C.F.R. 1.136(a)(3)).

Bruce H. Bernstein
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Reg. No. 31,296

P24171.A03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Yoshiyuki MURAOKA et al.	**Confirmation No.: 6632**
Serial No.:	10/654,881	Art Unit: 1745
Filed:	September 5, 2003	Examiner: Weiner, Laura
For:	RECHARGEABLE BATTERY AND MANUFACTURING METHOD THEREOF	

ELECTION WITH TRAVERSE

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Window, Mail Stop Amendment
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This is in response to the requirement for restriction under 35 U.S.C. § 121 mailed from the U.S. Patent and Trademark Office on May 11, 2006. Inasmuch as the one-month shortened statutory period is originally set in the Office Action to expire on June 12, 2006 (June 11, 2006 being a Sunday), this response is being filed by the initial due date for response and no extension of time is believed necessary. However, if any extension of time is deemed necessary, this is an express request for any necessary extension of time and authorization to charge any required extension of time fee or any other fees which may be required to preserve the pendency of the present application to Deposit Account No. 19-0089.

RESTRICTION REQUIREMENT

The Examiner has required restriction to one of the following inventions:

I. Claims 1-7, drawn to a battery, classified in class 429, subclass 209.

II. Claims 8-10, drawn to a method of making a battery, classified in class 29, subclass 623.1.

ELECTION

In order to be responsive to the requirement for restriction, Applicants elect, with traverse the invention set forth in claims 1-7 (Invention I as identified in the Restriction Requirement).

TRAVERSE

Applicants respectfully submit that a restriction is inappropriate in this case. In particularly, the Restriction Requirement appears to allege that the instant process can be used not only for manufacturing a rechargeable battery, but for any process that requires metal particles with a mean particle diameter of 0.5 to 4.0 μm (page 2, 2nd paragraph). In this regard, Applicants note that, a mean particle diameter of 0.5 to 4.0 μm is not recited in independent process claim 8, but only in dependent claim 10. Further, independent process claim 8 recites, *inter alia*, a positive electrode, a negative electrode and a separator interposed therebetween, a current collector and an electrolyte. The Examiner has failed to set forth which product that is different from a (rechargeable) battery can be made by a corresponding process.

For the foregoing reasons alone, the requirement for restriction is unwarranted in the present case.

Further, even if one were to assume, *arguendo*, that the inventions of Groups I and II are distinct, the requirement for restriction should be withdrawn, because there is no serious burden.

In MPEP Chapter 800, the Office sets forth its policy by which examiners are guided in requiring restriction under 35 U.S.C. § 121. Section 803 states that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

Applicants note that both of the inventions identified in the Restriction Requirement relate generally to a rechargeable battery. Accordingly, as a practical matter, the searches for inventions I and II should significantly overlap. For example, a search for invention I should cover many areas that are also relevant for invention II and *vice versa*. Accordingly, the searches for inventions I and II would be essentially coextensive. Thus, the search burden would not be serious.

Also, even if one were to assume that the searches for the inventions of Groups I and II are not completely coextensive, this would not appear to give rise to an undue search burden.

Further, the possible burden of some additional searching that may be required if both of the present inventions were searched at once would appear to be outweighed by far by the economic benefit of avoiding the need for two separate but significantly overlapping searches (possibly by two different Examiners).

For at least all of the foregoing reasons, the Restriction Requirement should be withdrawn, which action is respectfully requested.

The Examiner is respectfully reminded of the rejoinder practice set forth in MPEP § 821.04, i.e., if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend or otherwise include all of the limitations of the allowable product claim will be rejoined.

Respectfully submitted,
Yoshiyuki MURAOKA et al.

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June 9, 2006
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